

1 The opinion in support of the decision being entered today is *not* binding precedent
2 of the Board.

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5
6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* CARL PHILLIP GUSLER and RICK ALLEN HAMILTON, II
12

13
14 Appeal 2007-1867
15 Application 09/864,113
16 Technology Center 3600
17

18
19 Decided: July 27, 2007
20

21
22 Before HUBERT C. LORIN, STUART S. LEVY, and ANTON W. FETTING,
23 *Administrative Patent Judges*.

24 FETTING, *Administrative Patent Judge*.

25 DECISION ON APPEAL
26
27

28
29 STATEMENT OF CASE

30 Carl Phillip Gusler and Rick Allen Hamilton, II (Appellants) seek review under
31 35 U.S.C. § 134 of a Non-Final rejection of claims 1-27, the only claims pending
32 in the application on appeal.

33 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

34
35 We AFFIRM.

1
2 The Appellants invented a way to automatically alert online shoppers to other
3 concurrently online shoppers, find other concurrently online shoppers, and let them
4 communicate together (Specification 3: 5-8).

5 An understanding of the invention can be derived from a reading of exemplary
6 claim 1, which is reproduced below [bracketed matter and some paragraphing
7 added].

8 1. A method for providing enhanced online shopping experiences to
9 online shoppers for automatic association of two or more online
10 shoppers, said method comprising the steps of:

11 [1] searching a list of concurrently online shoppers according to a set
12 of search criteria,

13 [a] said shoppers each contemporarily being a user of a
14 common virtual shopping resource,

15 [b] said shoppers *being otherwise disassociated with each*
16 *other*;

17 [2] notifying a first online shopper that at least one other concurrently
18 online shopper meets said search criteria, and

19 [3] automatically associating said first online shopper with said one or
20 more concurrently online shoppers meeting said criteria. (emphasis
21 not in original.)
22

23 This appeal arises from the Examiner's Non-Final Rejection, mailed June 21,
24 2006. The Appellants filed an Appeal Brief in support of the appeal on September
25 15, 2006, and an Examiner's Answer to the Appeal Brief was mailed on November
26 20, 2006. A Reply Brief was filed on January 18, 2007.
27

PRIOR ART

The Examiner relies upon the following prior art:

Tang US 6,349,327 B1 Feb. 19, 2002

Kenney US 6,381,583 B1 Apr. 30, 2002

Surfing, Daily Herald, Arlington Heights, Ill., p. 1, Dec. 6, 1999 (Surfing)

Odigo.com, Web Site Pages, 16 pages (numbered 4-19), May 10, 2000 (Odigo
Web Pages)

REJECTIONS

Claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 stand rejected under 35
U.S.C. § 102(b) as anticipated by Odigo.com as evidenced by Surfing and
Odigo.com web pages¹.

Claims 2, 5, 6, 11, 14, 15, 20, 23, and 24 stand rejected under 35 U.S.C. §
103(a) as unpatentable over Odigo.com and Tang.

Claims 7, 16, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable
over Odigo and Kenney.

¹ The Examiner presents two essentially duplicate rejections, both for the same claims, over the same art, i.e., Odigo.com (Answer 7-8), and we consolidate them for purposes of this appeal.

ISSUES

Thus, the issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 under 35 U.S.C. § 102(b) as anticipated by Odigo.com as evidenced by Surfing and Odigo.com web pages.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 2, 5, 6, 11, 14, 15, 20, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Odigo.com and Tang.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 7, 16, and 25 under 35 U.S.C. § 103(a) as unpatentable over Odigo and Kenney.

The pertinent issue turns on whether Odigo.com shows disassociated shoppers as in element (1b) of claim 1, *supra*.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Claim Construction

01. The Specification does not define the word “disassociated.”

1 02. Disassociate means to remove from association².

2 03. To associate, in the context of shoppers, means to spend time socially;
3 keep company^{2,3}.

4 04. Thus, the ordinary and usual meaning of the claim limitation
5 “shoppers being otherwise disassociated with each other” is that of
6 shoppers not spending time socially or keeping company.

7 *Surfing*

8 05. Odigo finds web sites other users are visiting, helps the user locate
9 other users the user wants to chat with at that site and then enables the
10 user to chat with the other users. (Surfing 2:Address: www.odigo.com.)

11 *Odigo.com Web Pages*

12 06. With its people-finding "radar", Odigo shows who's surfing on the
13 same site as the user - or on any other website - at a moment. All the
14 users have to do is click on any person icon, open a message window,
15 and start chatting. (Odigo Web Pages 8: Second ¶ under The best way to
16 meet people while surfing.)

17 07. Odigo members of all ages and with specific interests can be found in
18 any geographical location a user wants. Use Odigo's search engine to
19 find exactly the person you want to meet; put together a group with a
20 common interest. (Odigo Web Pages 9: First ¶ under Find people using
21 Odigo's search engine.)

² American Heritage Dictionary of the English Language (4th ed. 2000).

³ The Appellants supply a definition from Merriam Webster which is essentially the same (Br. 7, second definition).

08. If a user wants to know a little something about a person before chatting, open the other user's Details Card with a right-click on any little figure, and select Show Details from the popup menu. The Details Card opens to reveal the user's profile ... everything one wants to know, and then some! If the first user likes what it sees, that user clicks on the Talk button and says Hi in the message window. (Odigo Web Pages 16: ¶ 1-3)

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580, 146 USPQ 69, 70 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671, 1674 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner

1 within the patent disclosure so as to give one of ordinary skill in the art notice of
2 the change).

3 *Anticipation*

4 "A claim is anticipated only if each and every element as set forth in the claim
5 is found, either expressly or inherently described, in a single prior art reference."
6 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d
7 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or
8 compositions, either generically or as alternatives, the claim is deemed anticipated
9 if any of the structures or compositions within the scope of the claim is known in
10 the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed.
11 Cir. 2001). "The identical invention must be shown in as complete detail as is
12 contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236,
13 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as
14 required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of
15 terminology is not required. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566,
16 1567 (Fed. Cir. 1990).

17 *Enablement of Prior Art*

18 Prior art must be enabling in rejections under 35 U.S.C. §§ 102 and 103, but
19 the standard of enablement is not that of 35 U.S.C. § 112.

20 A patent claim "cannot be anticipated by a prior art reference if
21 the allegedly anticipatory disclosures cited as prior art are not
22 enabled." *Elan Pharm., Inc. v. Mayo Found. for Med. Educ. &*
23 *Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). The standard for
24 what constitutes proper enablement of a prior art reference for
25 purposes of anticipation under section 102, however, differs from the
26 enablement standard under section 112. In *In re Hafner*, 410 F.2d
27 1403 (CCPA 1969), the court stated that "a disclosure lacking a
28 teaching of how to use a fully disclosed compound for a specific,

1 substantial utility or of how to use for such purpose a compound
2 produced by a fully disclosed process is, under the present state of the
3 law, entirely adequate to anticipate a claim to either the product or the
4 process and, at the same time, entirely inadequate to support the
5 allowance of such a claim.” *Id.* at 1405; *see Schoenwald*, 964 F.2d at
6 1124; *In re Samour*, 571 F.2d 559, 563-64 (CCPA 1978). The reason
7 is that section 112 “provides that the specification must enable one
8 skilled in the art to ‘use’ the invention whereas [section] 102 makes
9 no such requirement as to an anticipatory disclosure.” (Citations
10 omitted).

11 *Rasmusson v. Smithkline Beecham Corp.*, 413 F.3d 1318, 1325, 75 USPQ2d 1297,
12 1302 (Fed. Cir. 2000).

13 *Obviousness*

14 A claimed invention is unpatentable if the differences between it and the
15 prior art are “such that the subject matter as a whole would have been obvious at
16 the time the invention was made to a person having ordinary skill in the art.” 35
17 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d
18 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 465
19 (1966).

20 In *Graham*, the Court held that that the obviousness analysis is bottomed on
21 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
22 determined; [(2)] differences between the prior art and the claims at issue are to be
23 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
24 U.S. at 17, 148 USPQ at 467. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734
25 82 USPQ2d at 1391. “The combination of familiar elements according to known
26 methods is likely to be obvious when it does no more than yield predictable
27 results.” *KSR*, at 1739, 82 USPQ2d at 1396.

28 “When a work is available in one field of endeavor, design incentives and
29 other market forces can prompt variations of it, either in the same field or in a

1 different one. If a person of ordinary skill in the art can implement a predictable
2 variation, § 103 likely bars its patentability.” *Id.* at 1740, 82 USPQ2d at 1396.

3 “For the same reason, if a technique has been used to improve one device,
4 and a person of ordinary skill in the art would recognize that it would improve
5 similar devices in the same way, using the technique is obvious unless its actual
6 application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field of
8 endeavor at the time of invention and addressed by the patent can provide a reason
9 for combining the elements in the manner claimed.” *Id.* at 1742, 82 USPQ2d at
10 1397.

11
12 ANALYSIS

13 *Claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 rejected under 35 U.S.C. §*
14 *102(b) as anticipated by Odigo.com as evidenced by Surfing and Odigo.com web*
15 *pages.*

16 The Appellants argue these claims as a group.

17 Accordingly, we select claim 1 as representative of the group. 37 C.F.R.
18 § 41.37(c)(1)(vii) (2006).

19 The Examiner found that

20 Odigo teaches a method and system for providing enhanced
21 online shopping experiences to online shoppers for automatic
22 association of two or more online shoppers, said method
23 comprising the steps of: searching a list of concurrently online
24 shoppers according to a set of search criteria, said shoppers

1 each contemporarily being a user of a common virtual shopping
2 resource, said shoppers being otherwise disassociated with each
3 other (see at least pages 1 - 8 and 11 -13); notifying a first
4 online shopper that at least one other concurrently online
5 shopper meets said search criteria; a associating said first online
6 shopper with said one or more concurrently online shoppers
7 meeting said criteria (see at least pages 1 - 2 and 7 - 9).

8 (Answer 7: Third full ¶.)

9 The Appellants contend that

10 the Examiner has erred in making these rejections in the
11 following ways:

12 (1) by improperly interpreting references for the basis of the
13 rejection leading to rejections under 35 U.S.C. §102(b) and
14 §103 which rely upon art that does not teach all of Appellants'
15 claimed elements, steps, and limitations;

16 (2) by basing rejections under 35 U.S.C. § 102(b) and § 103 on
17 art which is not enabling to those ordinarily skilled in the art;
18 and

19 (3) by improperly combining references in the basis for a 35
20 U.S.C. § 102(b).

21 (Answer 4:Bottom of page.)

Appellants' Argument (1) that the art omits all the claimed elements

The Appellants summarize this argument as that “[t]he question then turns on to whether or not Odigo users are ‘previously disassociated’ with each other, as we have claimed.” (Br. 8:¶2.)

The Appellants contend that Odigo users are not disassociated with each other because

The other pages from the Odigo archive are clearly disclosing a "community" of users formed by installing and joining or using the Odigo product. These users have profiles, and even pictures, previously associated with their Odigo member ID numbers. As such, all users of Odigo are "previously associated" (not previously disassociated) with each other, before they visit a common web site, even if they have not actually communicated with each other yet.

(Br. 8: Last ¶.)

Thus, whether the users in Odigo are disassociated with each other depends on whether the mere fact that those users are registered with Odigo renders them associated with each other.

Claims are construed in their broadest reasonable interpretation during patent prosecution. Clearly, the environment of the invention is a shopping environment, an inherently social environment. Thus, the ordinary and usual meaning of the claim limitation “shoppers being otherwise disassociated with each other” is that of shoppers not spending time socially or keeping company (FF 04).

1 Further, the mere fact that a user chooses to associate itself with Odigo does
2 not automatically associate that user with all the other users of Odigo, except in the
3 same sense that all people are associated with each other by being members of a
4 common group, homo sapiens. Clearly the claim cannot support a construction in
5 which any logical, rather than social, connection forms the basis of association.

6 Odigo introduces users who are shoppers who have not previously socialized
7 or interacted with each other (FF 05-0). Thus, these users are shoppers being
8 otherwise disassociated with each other. Therefore we find this Appellants'
9 argument to be unpersuasive.

10
11 *Appellants' Argument (2) that the art is not enabling*

12 The Appellants recite that

13 Art cited under 35 U.S.C. § 102(b) must enable the public to
14 practice the invention. If the cited art is an issued U.S. patent,
15 enablement is presumed due to presumption of validity of
16 patents. However, if the cited art is non-patent literature, as
17 Surfing and Archive are, enablement is not presumed.
18 Consequently, if a non-patent literature reference is not
19 enabling, then [the rejection under § 102(b) is improper.]

20 (Br. 11, First full ¶.) The go on to state that “[e]nablement is met only if the
21 public is put into possession of both how to use and how to *make* the invention, not
22 just install it and use it.” (Br. 11: Third full ¶.)

23 The Appellants are conflating the enablement requirements of 35 U.S.C. §112,
24 first paragraph with the requirements for the public be in possession of prior art

(See *Rasmusson, supra*). Insofar as enabling one of ordinary skill to practice the steps in claim 1, this would have been accomplished by following the directions in the Odigo web site pages. Therefore, we find this Appellants' argument to be unpersuasive.

Appellants' Argument (3) that the Examiner improperly combined references in the basis for a 35 U.S.C. § 102(b) rejection.

The Appellants contend that

If treated as an individual references under 35 U.S.C. § 102(b), each must teach all of the claimed elements, steps, and limitations, which they fail to do as previously discussed. And, to treat them collectively as a single reference under 35 U.S.C. § 102 improperly circumvents the requirements of establishing a prima facie case of obviousness under 35 U.S.C. § 103, which fails to afford Appellant the opportunity to address them individually for their individual teachings, or to rebut any presumptions of conditions for obviousness.

(Br. 11, Last full ¶.) The Examiner has not rejected the claims over the references. Instead, the Examiner has rejected the claims over the web site Odigo as prior art. To provide evidence that the single web site Odigo meets the limitations of the claims, the Examiner has provided two references, each of which discusses aspects of that same single Odigo web site as prior art. Thus, the Examiner's rejection is not either of the two examples discussed in the above Appellants' contention, but another, valid, example of a rejection over novelty. Therefore, we find this Appellants' argument to be unpersuasive.

1
2 The Appellants have not sustained their burden of showing that the Examiner
3 erred in rejecting claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 under 35
4 U.S.C. § 102(b) as anticipated by Odigo.com as evidenced by Surfing and
5 Odigo.com web pages.

6
7 *Claims 2, 5, 6, 11, 14, 15, 20, 23, and 24 rejected under 35 U.S.C. § 103(a) as*
8 *unpatentable over Odigo.com and Tang.*

9 The Appellants have not separately argued these claims and thus they stand or
10 fall with their base claims. Thus the Appellants have not sustained their burden of
11 showing that the Examiner erred in rejecting claims 2, 5, 6, 11, 14, 15, 20, 23, and
12 24 under 35 U.S.C. § 103(a) as unpatentable over Odigo.com and Tang.

13
14 *Claims 7, 16, and 25 rejected under 35 U.S.C. § 103(a) as unpatentable over*
15 *Odigo and Kenney.*

16 The Appellants have not separately argued these claims and thus they stand or
17 fall with their base claims. Thus the Appellants have not sustained their burden of
18 showing that the Examiner erred in rejecting claims 7, 16, and 25 under 35 U.S.C.
19 § 103(a) as unpatentable over Odigo and Kenney.

20
21 CONCLUSIONS OF LAW

22 The Appellants have not sustained their burden of showing that the Examiner
23 erred in rejecting claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 under 35

U.S.C. § 102(b), or claims 2, 5-7, 11, 14-16, 20, and 23-25 under 35 U.S.C.
§ 103(a) as unpatentable over the prior art.

On this record, the Appellants are not entitled to a patent containing claims 1-
27.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 3, 4, 8-10, 12, 13, 17-19, 21, 22, 26, and 27 under 35 U.S.C. § 102(b) as anticipated by Odigo.com as evidenced by Surfing and Odigo.com web pages is sustained.
- The rejection of claims 2, 5, 6, 11, 14, 15, 20, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Odigo.com and Tang is sustained.
- The rejection of claims 7, 16, and 25 under 35 U.S.C. § 103(a) as unpatentable over Odigo and Kenney is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

jlb

IBM Corporation (RHF)
C/O Robert H. Frantz
P.O. Box 23324
Oklahoma City, OK 73123